REMARKS

This Amendment is in response to the Final Office Action dated July 15, 2003 (hereinafter the "July 15 Office Action"). In the July 15 Office Action, the Examiner noted that the corrected and substitute drawings (sent on March 21, 2003 as part of an Amendment and Response to the First Office Action, hereinafter the "March 21 Response"), were acceptable, thus overcoming previous objections cited in the First Office Action dated November 21, 2002 (hereinafter the "November 21 Office Action"). Also, in the July 15 Office Action, the Examiner noted that the previous amendments to claims 12 and 16 were acceptable, thus overcoming the rejections under 35 U.S.C. § 101. Last, claims 2-6, and 10-24 were rejected under 35 U.S.C. § 112, first paragraph; and claims 7-15 were rejected under 35 U.S.C. § 102(b) as being anticipated by Blickstein (USPN 5,577,253).

As an initial matter, it is unclear whether the Examiner examined the original claims 1-24 in the July 15 Office Action or the claims 2-24, as amended in the March 21 Response. That is, claim 1 is noted as pending on the cover sheet of the May 23 Office Action, yet that claim was canceled in the March 21 Response. Further the Examiner repeated the rejections from the November 21 Office Action "in response to the Applicant's original claims 1-24." (July 15 Office Action, p. 3). That said however, Applicant believes that the cover sheet entry is merely a typographical error and that the quotation on page 4 is merely an indication that the same rejections cited in the November 21 Office Action are being applied/maintained to the existing pending claims. If this belief is in error, then Applicant respectfully clarification of the rejections since rejections of non-pending claims will not provide readily definable issues for appeal. See MPEP 707.

In this response, claim 12 has been amended, and no claims have been canceled or added. Claims 2-24 are currently pending. Reexamination and reconsideration of the outstanding rejections in light of these amendments and remarks are respectfully requested.

Claim Rejections – 35 U.S.C. § 112

Claims 2-6, and 10-24 have been rejected under 35 U.S.C. § 112, first paragraph, as

containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In particular the Examiner has repeated, verbatim, the previous rejection under § 112, apparently reasserting the same logic for this rejection. This rejection is based on the allegation that the "process or processes of consuming or re-compiling a 'common language file' or 'library' in conjunction with a native source code file can be pursued in two different and opposing directions." (July 15 Office Action, p. 4). The original § 112 rejection cited in the November 21 Office Action relied on this logic alone for rejecting the claims.

In response, the Applicant provided significant explanation of the process of consuming common language files with references to the specification. Indeed, the March 21 Response directed the Examiner's attention to the explanations provided with respect to Figs. 6 and 7, which relates to five or more pages in the specification. (See March 21 Response, pp. 16-17.) In this description, methods are described that would enable one of ordinary skill in the art to make and use the present invention. In particular, the description in the specification describes how to consume a common language file in combination with a native source file, whether the common language file is called a file or a library file.

Although the Applicant provided such explanation, the Examiner mistakenly alleges that the Applicant only provided "a total of five lines regarding 'consuming' of common language files." (July 15 Office Action, p. 2). Next, the Examiner provides details as to how BSD/Linux compiles files into common language files, defined by the Examiner as .o object files. Upon concluding that those skilled in the art can define a common language file and then incorporate the file at compile time or run-time, the Examiner states that those skilled in the art cannot recompile "all" common language format files without undue experimentation. Based on this new ground for rejection, the Examiner inexplicably "maintains" the previous 112 rejection. The Applicant hereby traverses both § 112 rejections as failing to provide a prima facie case of lack of enablement.

First, the original § 112 rejection should be withdrawn. As discussed above, the Applicant has provided significant explanation, with citations to the specification that those skilled in the art can make and use the present invention in light of the two possible methods noted by the Examiner. The Applicant's explanation has not been rebutted by the Examiner other to mistakenly allege (a) that only five lines were provided in response when clearly more discussion was provided and (b) assuming *arguendo* that only five lines were provided, that five lines is not enough to enable one skilled in the art. Consequently, the Examiner has not established a prima facie case of non-enablement based on the assertion that the description provides at least two methods of achieving the end result. Reconsideration of this rejection is hereby requested.

Second, the new 112 rejection, based on the assertion that one skilled in the art would be unable to reproduce the "consumption" or re-compilation" of all common language files without undue experimentation should be withdrawn. The Examiner has not provided any evidence or explanation as to why one skilled in the art would be unable to reproduce the claimed elements without undue experimentation. The Examiner has not commented on the state of the prior art with respect to the level of one skilled in the art. If anything, the Examiner's own description of the BSD/Linux use of libraries indicates that those skilled in the art are highly sophisticated and able to understand the complexities of compiling, re-compiling and/or consuming program files. Moreover, the fact that experimentation may be necessary, and may be complex, does not mean that the experimentation is necessarily undue. See MPEP § 2164.01 (citations omitted.)

The Examiner asserts that the specification does not provide adequate enabling description of how to make and use the invention as defined in the specification because "one skilled in the art would be unable to reproduce the 'consumption' or 're-compilation' of all common language files." There is no discussion in the Office Action however as to why the enabling description as to some common language files cannot be applied, with predictability to all common language files. Indeed, under MPEP § 2164.04 "specific technical reasons [to support a prima facie case of lack of enablement] are always required." Without such reasons, the 112 rejection based on undue experimentation should be withdrawn.

Last, the status of the July 15 Office Action should not be made Final. Since new references were cited and since new arguments were provided, the July 15 Office Action was improperly made final. MPEP § 2164.04 states that "[c]iting new references and/or expanding arguments in a second Office action could prevent that action from being made final." In this case, not only were new references cited, but the argument was new and different from the previous Office Action. Reconsideration of the status of the July 15 Office Action as final is hereby requested.

Claim Rejections – 35 U.S.C. § 102

Claims 1, 7-9, and 12-15 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Blickstein (USPN 5,577,253).

As an initial matter, dependent claims 10 and 11 also appear to be rejected under 35 U.S.C. § 102(b). However, these claims were not originally rejected under § 102, yet these claims have always depended from claim 7. The Examiner did not provide any specific indication as to why these claims are now rejected under § 102. It appears that the Examiner has grouped claims 10 and 11 in with claims 7-9, yet the Applicant is unable to determine this with certainty. Under MPEP 707.07(d), this is an improper rejection. More importantly, the rejection of claims 10 and 11 under 35 U.S.C. § 102(b) is a new ground for rejection such that the final status of the Office Action is improper and applicant hereby requests reconsideration of the status of the July 15 Office Action.

In reference to the remaining claims rejected under 35 U.S.C. § 102(b), Applicant again respectfully traverses the Examiner's rejections based on the Blickstein reference cited above. That is, the cited reference does not identically disclose all of the limitations of the claimed invention. As stated in the March 21 Response, with respect to claim 7, Blickstein does not identically disclose "a common language instructions section having instructions in a common language, the instructions related to the written program functions of the native source code file and consumed metadata." In response, the Examiner has merely cited a single passage from

9

Blickstein that states "The internal representation of a module 21 comprises a symbol table 30 for the module and a compact intermediate language graph 55 or CILG, for each subroutine in source module 21." This reference does not indicate that the symbol table or the CILG is related to a native source code file and consumed metadata. Indeed, nothing in the Blickstein reference contemplates consuming metadata as part of the front end process, thus nothing in the Blickstein reference describes, explicitly or inherently, instructions related to both a native source code file and consumed metadata.

Similarly, with respect to amended claim 12, Blickstein does not identically disclose an executable instructions section comprising instructions representing a plurality of source languages. That is, the instructions section has a plurality of instructions and at least two of these instructions originate from different source languages. Blickstein only provides the one source language file 21. It does not indicate that other source languages can be compiled into a single instructions section of a common language file. Although Blickstein provides a relatively generic interface, each front end can only consume or compile a single language. Consequently, the instructions section of a single instance of a common language file of Blickstein cannot simultaneously reflect the content of written functions of multiple source languages. That is, each intermediate language file generated by can only represent the content of one native source language.

Under 35 U.S.C. § 102, a reference must show or describe each and every element claimed in order to anticipate the claims. *Verdegaal Bros. v. Union Oil Co. of California* 814 F.2d 628 (Fed. Cir. 1987) ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.").

Since Blickstein does not disclose the use of an instruction section of a file for representing instructions originally represented in different languages, Blickstein cannot, as a matter of law, anticipate claims 7 and 12. Further, claims 8-11 depend directly from claim 7 and claims 13-15 depend directly from claim 12 such that claims 8-11 and 13-15 should also be allowed over Blickstein.
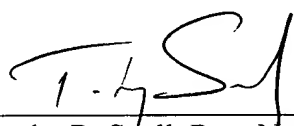
Conclusion

Following the last Amendment and Response, the present application included 23 claims, 8 of which were independent. As amended, the present application now includes 23 claims, 8 of which are independent. Accordingly, it is believed that no further fees are due with this Response. However, the Commissioner is hereby authorized to charge any deficiencies or credit any overpayment with respect to this patent application to deposit account number 13-2725.

In light of the above remarks and amendments, it is believed that the application is now in condition for allowance, and such action is respectfully requested. Should any additional issues need to be resolved, the Examiner is requested to telephone the undersigned to attempt to resolve those issues.

Respectfully submitted,

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